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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,419	10/22/2003	Kevin G. Currans	1000 1596-6	8513
22879 7590 12/28/2009 HEWLETT-PACKARD COMPANY Intellectual Property Administration 3404 E. Harmony Road Mail Stop 35 FORT COLLINS, CO 80528			EXAMINER WINTER, JOHN M	
			ART UNIT 3685	PAPER NUMBER
			NOTIFICATION DATE 12/28/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/692,419

Applicant(s)

CURRANS ET AL.

Examiner

JOHN M. WINTER

Art Unit

3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15, 20, 22 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15, 20, 22 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. The Applicant's amendment filed on October 8, 2009 is hereby acknowledged, Claims 15, 20, 22 and 24 remain pending.

Response to Arguments

2. Applicant's arguments with respect to the pending claims have been fully considered.
3. The Examiner states that the applicants arguments Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008). The present invention fails to be tied to a specific device , and is therefore rejected under 35 U.S.C. 101.
4. The Applicant states that the prior art does not disclose the claimed feature of "creating a digital cash account in a memory device for the consumable item having an amount proportionally related to the amount of the consumable item"

The Examiner responds that *Briscoe* ('273) discloses creating a digital cash account for the consumable item having an amount proportionally related to the amount of the consumable item; (Column 5, lines 12-31). The cash stick (e.g. consumable item) has a monetary value

associated with it that is expended as the cash stick is used, initially the value of the cash stick to 100% the value of the associated asset (e.g. proportionally related).

The Applicant states that the prior art does not disclose the claimed feature of "preventing the use of a portion of the consumable item by a valve in proportion to the amount of the expended portion of the currency."

The Examiner responds that Courdrey et al. discloses preventing the use of the consumable item by a valve in proportion to the reduced amount of the digital cash account of the consumable item, thereby bartering a portion of the consumable item for the use of the content;(Column 7, line 47 – column 8, line 5; and figure 6). Courdrey et al. discloses a system where the amount of postage issued on a certain day is a limited fraction of the total amount of postage available, because Courdrey et al. regulates via a metering mechanism (e.g. valve) the usage of postage (e.g. consumable item) by a set amount (e.g. in proportion to the amount of the expended portion of the currency) the Examiner submits that the prior art meets the claimed limitation.

The Applicant states that the method of claim 20 is directed to using the consumable item as barter for cash. The ability to use the consumable item both for creating the privileged content as well as an article of value which can be bartered away is believed to be both novel and non-obvious.

The Examiner replies that claim 20 recites in part "wherein the use of the consumable item to recreate the royalty based content incurs the debit charge" The Examiner submits that the claim as stated has a broader scope than using the content structurally to recreate content, the scope of the claim includes processes as described by the prior art where the

“consumable item” is a monetary value, and it’s “use” is to acquire right to access/recreate etc.. content, therefore the Examiner submits that the prior art sufficiently rejected the claimed invention. Additionally the Examiner notes that a wherein clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim. (Texas Instruments Inc. v. International Trade Commission 26, USPQ2d 1010 (Fed. Cir. 1993); Griffin v. Bertina, 62 USPQ2d 1431 (Fed. Cir. 2002); Amazon.com Inc. v. Barnesandnoble.com Inc., 57 USPQ2d 1747 (CAFC 2001), therefore the claimed feature recited above does not have patentable merit.

Applicants also note that it is improper to combine references where the references teach away from their combination.

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 15, 20, 22 and 24 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.
6. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).
7. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.
8. To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.
9. In this particular case, claim 15 fails prong (1) because the “tie” (e.g. consumable item) is representative of extra-solution activity. Additionally, the claim(s) fail prong (2) because

the method steps do not transform the underlying subject matter to a different state or thing.

10. Claims 20,22, and 24 are either dependant upon claim 15 or contain similar limitations and are rejected for at least the same reasons.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 15, 20, 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Briscoe. (US Patent 6,341,273) in view of Berstis et al. (US Patent 6,282,653) and further in view of Cordery (US Patent 5,655,023)

13. As per claims 15 and 20,

Briscoe ('273) discloses a method of exchanging payments, comprising the steps of:
purchasing a consumable article having a consumable item therein configured to allow recreation of royalty based content; (Column 6, lines 49-58)
creating a digital cash account for the consumable item having an amount proportionally related to the amount of the consumable item; (Column 5, lines 12-31)
expending a portion of the consumable item with the consumable article wherein the use of

the consumable item to recreate the royalty based content
incurs [[a]]the debit charge; (Column 6, lines 8-46)
reducing the amount of the digital cash account over a network by the
amount of the debit charge incurred; (Column 6, lines 8-46)

14. Briscoe ('273) does not explicitly disclose

preventing the use of the consumable item by a valve in proportion to the reduced amount
of the digital cash account of the consumable item, thereby bartering a portion of the
consumable item for the use of the content; Courdrey et al. ('023) discloses preventing the
use of the consumable item by a valve in proportion to the reduced amount of the digital
cash account of the consumable item, thereby bartering a portion of the consumable item
for the use of the content;(Column 7, line 47 – column 8, line 5; and figure 6) It would be
obvious to one having ordinary skill in the art at the time the invention was made to
combine the Briscoe ('273) method with the Courdrey et al. ('023)method in order to
recoup the expense of product development. Examiner notes a thereby clause that merely
states the result of the limitations in the claim adds nothing to the patentability or
substance of the claim (Texas Instruments Inc. v. International Trade Commission 26,
USPQ2d 1010 (Fed. Cir. 1993); Griffin v. Bertina, 62 USPQ2d 1431 (Fed. Cir. 2002);
Amazon.com Inc. v. Barnesandnoble.com Inc., 57 USPQ2d 1747 (CAFC 2001)

15. Briscoe ('273) does not explicitly disclose acquiring, a first royalty based content that
indicates an owner of the content and the amount of a debit charge for using the content;
and updating a digital cash account over a network for the owner of the royalty based
content by the amount reduced from the digital cash account for the consumable item.

16. Berstis et al. ('653) discloses acquiring, a first royalty based content that indicates an owner of the content and the amount of a debit charge for using the content; and updating a digital cash account over a network for the owner of the royalty based content by the amount reduced from the digital cash account for the consumable item. (Abstract, Column 6, line 43 – Column 7 line 29, discussion of royalty payment for usage –prepaid amount to reduce pre rendering of content) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Briscoe ('273) method with the Berstis et al. ('653) method in order to recoup the expense of product development
17. As per claims 22 and 24,
Briscoe ('273) discloses an apparatus including a consumable item configured to use the method of claim 15 to exchange payments. (Abstract)

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMW

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685